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Application Number	09/874,031
Filing Date	06/06/2001
First Named Inventor	Roskin
Group Art Unit	3643
Examiner Name	A.M. Valenti
Attorney Docket Number	Roskin-1

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## ENCLOSURES (check all that apply)

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Remarks

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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Patent Application of:  
**Linda Roskin**

Serial No.: 09/874,031

Filed: June 06, 2001

For: **DEVICE AND METHOD FOR ADAPTING  
A CONTAINER FOR USE IN A FLORAL  
ARRANGEMENT**

Commissioner of Patents and Trademarks  
Arlington, VA



Examiner: **Andrea Valenti**

Group Art Unit: **3643**

Date: **October 26, 2004**

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**APPEAL BRIEF OF APPELLANT**

Sir:

The Applicant has filed a timely Notice of Appeal from the action of the Examiner dated August 26, 2004, finally rejecting Claims 5 and 7-22. The Applicant herein timely files this Brief in accordance with 37 C.F.R. 1.192(a).

**I. PARTY IN INTEREST [37 CFR §1.192(c)(1)]**

The subject application is not assigned. As such, the Party in Interest is the Applicant.

**II. RELATED APPEALS AND INTERFERENCE [37 CFR §1.192(c)(2)]**

No other related application is currently subject to an Appeal or Interference.

This application was the subject of a previous filed appeal. (Appeal No. 2003-1855). A

copy of the Decision On Appeal is provided as Exhibit 1.

### **III. STATUS OF CLAIMS [37 CFR §1.192(c)(3)]**

Claims 5 and 7-22 are pending in this application.

Claims 5 and 7-22 stand as finally rejected by the Examiner.

### **IV. STATUS OF THE AMENDMENTS [37 CFR §1.192(c)(4)]**

The amendment filed by the Applicant on March 17, 2004 was entered by the Examiner.

No other amendments were filed.

### **V. SUMMARY OF THE INVENTION [37 CFR §1.192(c)(5)]**

The subject application has three pending independent claims, which are Claim 11, Claim 19 and Claim 22.

Claim 11 is an independent claim that sets forth an assembly consisting of a container and an elastomeric cover for that container. (See **preamble of Claim 1**). The claimed assembly includes a container (See **vase 12 in Fig. 1 or vase 22 in Fig. 2**). The container has an open top end of a predetermined maximum width. (See **diameter D2 in Fig. 1**) Also claimed as part of the assembly is an elastomeric cover element (**10 in Figs. 1-3**) that is used to cover the open top end of the container. The elastomeric cover element (**10**) has an unstretched width that is smaller than the maximum width of the container's open top end. (See **width dimension D1 in Fig. 1 and Fig. 2**) (See also *Specification, page 8, lines 22-23 and page 10, lines 1-5*) As such, the cover element (**10**) must be elastically stretched into a stretched width that is greater than the maximum width of open top end of the container (**12 in Fig. 1, 22 in Fig. 2**) to cover the open top end of the container. (See *Specification, page 9, lines 1-4 and page 10, lines 8-12*) A grid pattern of openings (**20 in Figs. 1-3**) is defined in the cover element (**10**). The grid pattern has multiple

rows and multiple columns, wherein multiple openings are arranged in each of said rows and each of said columns. *(See embodiment of Fig. 1 and Fig. 2) (See also Specification, page 8, lines 10-14).* The openings are used to arrange flowers *(14, Fig. 1)* once the cover element is stretched over the open top end of the container. *(See Summary, page 6, lines 1-8)*

Claim 19 sets forth a method of preparing a vase for a floral arrangement. *(See preamble to Claim 19)* The method includes providing an elastomeric cover *(10 in Fig. 1-3)* that contains a plurality of openings *(20 in Figs. 1-3)* that are arranged in a grid pattern. As can be seen from Figs 1-3, multiple openings *(20)* are present in each row and in each column. The elastomeric cover *(10)*, however, has a width that is less than the maximum width of vase *(12 in Fig. 2, 22 in Fig. 2)* it is to cover. *(See also Specification, page 8, lines 22-23 and page 10, lines 1-5)* The elastomeric cover *(10)* is stretched over the open top of the vase *(12, 22)*, wherein the width of the elastomeric cover *(10)* is elastically increased to a width greater than that of the open top of the vase. *(See pre-stretched and stretched diameters of elastomeric cover 10 in Fig. 2) (Also see Specification, page 9, lines 1-4 and page 10, lines 8-12)*

Claim 22 is an independent claim that sets forth a floral arrangement cover for a vase. *(See preamble to Claim 22.)* The claimed cover *(10)* has an elastic planar top surface *(16)* in which are defined a grid pattern of openings *(20)*. As can be seen from Figs 1-3, multiple openings *(20)* are present in each row and in each column of the grid pattern. An elastic peripheral wall *(18)* extends downwardly from the planar top surface *(16)*. Both the elastic planar top surface *(18)* and the elastic peripheral wall *(18)* are elastically stretchable to a stretched size where the peripheral wall can receive the open top of the vase therein. *(See specification Page 8, line 16- page 9, line 14).* Once placed around the vase, the elastic planar top spans the open top of the vase and the peripheral wall engages the vase by contracting around its open top. *(See Specification, page 10, lines 15-21)*

## **VI. ISSUES. [37 CFR §1.192(c)(6)]**

The issues presented on review are as follows:

**ISSUE 1 -** Whether the Examiner erred in finally rejecting Claims 5-7, 9-15 and 17-22 under 35 USC 103(a) as being unpatentable over European Patent Reference No. 0182453 to Turner in view of U.S. Patent No. 4,901,881 to McElroy.

**ISSUE 2 -** Whether the Examiner erred in finally rejecting Claims 8 and 16 under 35 USC 103(a) as being unpatentable over European Patent Reference No. 0182453 to Turner in view of U.S. Patent No. 2,876,587 to Saks

**ISSUE 3 -** Whether the Examiner erred in finally rejecting Claims 5-22 because the Examiner has no proper motivation for the combinations made, thereby producing a wrongful hindsight reconstruction.

## **VII. GROUPING OF CLAIMS. [37 CFR §1.192(c)(7)]**

The present application contains three independent claims, which are Claims 11, 19 and 22. Claim 11 sets forth an assembly consisting of a container and a cover. Claim 19 sets forth a method of preparing a vase for a floral arrangement. Lastly, Claim 22 sets forth a floral arrangement cover for a vase. Since the three independent claims claim different applications of the present invention, the three independent claims will be argued separately. Accordingly, it is believed that the three independent claims should be considered separately and should not stand and fall together.

## **VIII. ARGUMENTS. [37 CFR §1.192(c)(7)]**

**ISSUE 1 -** Whether the Examiner erred in finally rejecting Claims 5-7, 9-15 and 17-22 under 35 USC 103(a) as being unpatentable over European Patent Reference No. 0182453 to Turner in view of U.S. Patent No. 4,901,881 to McElroy.

The rejected claims contain all three independent claims. These claims are Claim 11, Claim 19 and Claim 22. These claims are fully distinguishable over the combined references, as is explained below.

### **Claim 11**

Claim 11 of the present application sets forth an assembly. The claimed assembly includes a container. The container has an open top end of a predetermined maximum width. Also claimed as part of the assembly is an elastomeric cover element that is used to cover the open top end of the container. The cover element has an unstretched width that is smaller than the maximum width of the container's open top end. As such, the cover element must be elastically stretched into a stretched width that is greater than the maximum width of open top end of the container to cover the open top end of the container. A grid pattern of openings are defined in the cover element. The grid pattern of openings positions multiple openings in multiple rows and columns. This grid pattern is necessary to evenly arrange multiple flowers once the cover element is stretched over the open top end of the container.

The claimed structure of Claim 11 is not disclosed by the Turner or McElroy patents.

**The Turner patent** discloses an open-mesh cover made from "one-sixteenth inch diameter plastic rods spaced one inch apart and fastened to a second set of such rods having their longitudinal axis at an angle of about 90 degrees". *See Turner page 4, second paragraph.*

In the preferred embodiment of the Turner patent, the open-mesh cover 'is held securely in place by a snap-lock mechanism." *See Turner, page 4, third paragraph.*

It is obvious from the description of Turner, that a static plastic mesh cover is described that is molded to fit only one specific container. The mesh cover can in no manner be stretched to fit containers of different shapes and sizes. It is therefore clear that the Turner patent does not disclose any type of cover element that is elastically stretched over a vase or any other type of container.

To address this obvious deficiency in the Turner patent, the Examiner cites the McElroy patent.

**The McElroy patent** discloses an elastic lid for a cup. In the preferred embodiment, the lid is for a "disposable cup such as found in fast food restaurants". *See McElroy, column 6, lines 53-54.* In the elastic lid is an aperture (20) for receiving a drinking straw. *See McElroy, column 8, lines 10-14.* As such, only one or possibly two drinking straw apertures are in the lid.

In combination, neither the Turner nor the McElroy patents disclose any type of cover for a vase or similar container, where the cover deforms and elastically stretches around the vase, thereby stretching a grid across the opening of the vase for use in floral arrangements. It is also clear that neither the Turner patent nor McElroy patent discloses or suggests a cover for a container that elastically stretches and that contains a grid pattern of openings that would act as a guide for symmetrically arranging flowers.

Claim 11 claims a cover element that defines a grid pattern of openings arranged in rows and columns. The cover element has an unstretched width that is smaller than the width of the container it is to cover. As such, the cover element must be elastically stretched to a wider width that can receive the top of the container.

Accordingly, it is clear that the Turner and McElroy patents do not disclose the matter contained in Claim 11 of the present application. The 35 USC 103 rejection for Claim 11 and its dependent claims should therefore be withdrawn.

In regard to Claim 12, neither the Turner patent nor the McElroy patent discloses a cover

that can be stretched around a non-symmetrical vase opening.

In regard to Claim 15, neither the Turner patent nor the McElroy patent discloses a cover that stretches open its grid structure as it is stretched over a vase.

### **Claim 19**

Claim 19 sets forth a method of preparing a vase for a floral arrangement. The method includes providing an elastomeric cover that contains a grid pattern of openings that are arranged in rows and columns. The elastomeric cover, however, has a width that is less than the maximum width of vase it is to cover. The elastomeric cover is stretched over the open top of the vase, wherein the width of said elastomeric cover is elastically increased to a width greater than that of the open top of the vase. In this matter, the grid pattern of openings can be suspended over a vase to provide a taut guide for arranging flowers.

As has been previously stated, the Turner patent does not disclose an elastomeric cover. As such, it does not disclose the method step of providing an elastomeric cover. Furthermore, the Turner patent does not disclose the method step of stretching an undersized cover into a larger shape that can be placed over the open end of a vase. Rather, the Turner patent discloses a plastic wire grid. The wire grid has one set width that does not change.

The McElroy patent discloses a cover for a fountain soda cup. The McElroy patent does not disclose the method step of stretching an undersized cover into a larger shape that can be placed over a vase, wherein the cover defines a grid pattern of multiple openings.

Accordingly, the combination of Turner and McElroy does not disclose the method of providing an undersized cover and elastically stretching that undersized cover to span the top of a vase. The 35 USC 103 rejection for Claim 19 and its dependent claims should therefore be withdrawn.

### **Claim 22**

Claim 22 is an independent claim that sets forth a floral arrangement cover for a vase.



The claimed cover has an elastic planar top surface in which are defined a grid pattern of openings that are arranged in rows and columns. An elastic peripheral wall extends downwardly from the planar top surface. Both the elastic planar top and the elastic peripheral wall are elastically stretchable to a stretched size where the peripheral wall can receive the open top of the vase. Once placed around the vase, the elastic planar top spans the open top of the vase and the peripheral wall engages the vase by contracting around its open top.

The Turner patent does not disclose a vase cover with an elastic top surface. The Turner patent does not disclose a vase cover with an elastic peripheral wall. Lastly, the turner patent does not disclose a vase cover that is stretched over a vase and engages the vase by contracting around the top of the vase.

The McElroy patent discloses a cover for a fountain soda cup. The McElroy patent does not disclose the method step of stretching an undersized cover into a larger shape that can be placed over a vase, wherein the cover defines a grid pattern of multiple openings.

Accordingly, the combination of Turner and McElroy does not disclose or suggest any undersized vase cover that is elastically stretched over a vase to create a grip pattern for floral arrangements. The 35 USC 103 rejection for Claim 19 and its dependent claims should therefore be withdrawn.

**ISSUE 2 -** Whether the Examiner erred in finally rejecting Claims 8 and 16 under 35 USC 103(a) as being unpatentable over European Patent Reference No. 0182453 to Turner in view of U.S. Patent No. 2,876,587 to Saks

This application was the subject to an earlier filed Appeal No. 2003-1855. A copy of the Decision On Appeal, dated September 17, 2003 is provided as Exhibit 1.

In the Decision On Appeal, on page 10, it is stated:

**“The appellant argues in the brief that there is no teaching, suggestion or motivation in the applied prior art (i.e, Turner, Eckman and Saks) for a person**

**of ordinary skill in the art, at the time the invention was made, to have modified Turner to arrive at the subject matter of independent claims 11, 19 and 22. We agree.”**

The current pending claims are no more broader than those previously considered on appeal. Thus, the appellant believes that the Examiner’s argument is moot in view of the Decision On Appeal already provided.

Claim 6 depends from independent Claim 22. Claim 16 depends from independent Claim 11. The matter contained in independent Claim 6 and independent Claim 22 both differ from the Turner patent for the reasons previously presented.

The Examiner cites the Saks patent to show a flow holding grid that is transparent. However, the Saks patent shows a device that is a solid, rigid piece of plastic. The Saks patent does not address the deficiencies of the Turner patent as applied to the wording of the independent claims. The Saks patent merely shows a plastic flower holder that is made of transparent plastic. The Saks patent makes no disclosure of an elastomeric cover for a vase that is stretched over a vase. Accordingly, the combination of Saks with the Turner patent fails to disclose the matter claimed by the present invention.

**ISSUE 3 -** Whether the Examiner erred in finally rejecting Claims 5-22 because the Examiner has no proper motivation for the combinations made, thereby producing a wrongful hindsight reconstruction.

The Examiner's rejection based upon the cited references requires a selective combination of various elements before the references can be applied to the pending claims. The law is clear. When prior art references require selective combination to render the claims of an application obvious, there must be some reason for the combination other than hindsight gleaned from the invention itself. See *Interconnect Planning Corp. v. Feil* 774 F.2nd 1138, 227 USPQ 543 (Fed Cir 1985), and *Ashland Oil, Inc.* 776 F.2nd 281, 227 USPQ 657 (Fed Cir 1985). Something in the prior art as a whole must suggest the desirability and thus the obviousness of making the combination. See *Lindermann Maschinenfabrik GmbH v. American Hoist and Derrick Co.* 730 F.2nd 1452, 221 USPQ 481 (Fed Cir. 1984), and *Uniroyal Inc. v. Rudkin-Wiley Corp.* 5 USPQ 2nd 1434 (1988). The mere fact that the prior art could be modified in the manner suggested by the examiner does not make such a modification obvious unless the applied prior art suggested the desirability of the modification. See *In re Gordon*, 773 F.2nd 900, 902, 221 USPQ 1125, 1127 (Fed Cir. 1984)

As the court stated in *Uniroyal*, 837 F.2nd at 1051, 5 USPQ2nd at 1438, "it is impermissible to use the claims as a frame and the prior art references as a mosaic to piece together a facsimile of the claimed invention." In regard to the matter set forth in Claims 11, Claim 19 and Claim 22, the prior art cited simply does not disclose any undersized vase cover that elastically stretches over a vase to provide a grid structure across the face of the vase. Since nothing in the cited art suggests what was claimed, the Examiner's combination is without motivation and is wrongful.

**CONCLUSION**

The Applicant's brief is believed to be in full compliance with 37 C.F.R. §1. 192(c) et seq. The Examiner's 35 U.S.C. §103 rejections are not supported by the cited references. The Board is therefore requested to cause the Examiner to remove the rejection and allow the remaining pending claims.

Respectfully Submitted,

A handwritten signature in black ink, appearing to read 'Eric A. LaMorte', written over a horizontal line.

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## **VII. APPENDIX.**

The pending claims stand as follows:

5. The device according to Claim 22, wherein said plurality of openings are symmetrically disposed throughout said planar top surface.
7. The device according to Claim 22, wherein said plurality of openings are slots that enlarge when said planar top surface is stretched.
8. The device according to Claim 22, wherein said planar top surface is translucent.
9. The device according to Claim 22, wherein said planar top surface has a circular peripheral shape.
10. The device according to Claim 22, wherein said planar top surface has a polygonal peripheral shape.
11. An assembly, comprising:
  - a container having an open top end with a predetermined maximum width;
  - an elastomeric cover element for covering said open top end, said cover element having an unstretched width that is smaller than said maximum width of said open top end wherein said cover element must be elastically stretched to a stretched width greater than said maximum width of said open top end to cover said open top end; and
  - a grid pattern of openings defined in said cover element, said grid pattern having multiple rows and multiple columns, wherein multiple openings are arranged in each of said rows and each of said columns.
12. The assembly according to Claim 11, wherein said open top end of said container is

not symmetrical and said cover element conforms to the open top end of the container when engaged with the open top of the container.

13. The assembly according to Claim 11, wherein said cover element has a planar top surface and a peripheral wall that extends downwardly from said planar top surface.

14. The assembly according to Claim 13, wherein said grid pattern is on said planar top surface.

15. The assembly according to Claim 13, wherein said openings are slots that enlarge when said cover element is stretched.

16. The assembly according to Claim 11, wherein said cover element is translucent.

17. The assembly according to Claim 11, wherein said cover element has a circular peripheral shape.

18. The assembly according to Claim 11, wherein said cover element has a polygonal peripheral shape.

19. A method of preparing a vase for a floral arrangement, wherein the vase has an open top with a maximum width at least one point, said method comprising the steps of:

providing an elastomeric cover, containing a plurality of openings that are arranged in a grid pattern of multiple rows and multiple columns, wherein said elastomeric cover has a width that is less than said maximum width of said vase, and wherein multiple openings are present in each of said rows and said columns;

stretching said elastomeric cover over said open top of said vase, wherein said width of said elastomeric cover elastically increases to a width greater than that of said vase and engages said vase around said open top.

20. The method according to Claim 19, wherein said cover has a planar top surface and a peripheral wall that extends downwardly from said planar top surface, wherein said grid pattern is on said planar top surface.

21. The method according to Claim 19, further including the step of inserting elements of a floral arrangement through said plurality of openings and into said vase.

22. A floral arrangement cover for a vase, wherein the vase has an open top, said cover comprising:

an elastic planar top surface in which are defined a plurality of openings that are arranged in a grid pattern of multiple rows and multiple columns, wherein multiple openings are disposed within each of said rows and said columns;

an elastic peripheral wall that extends downwardly from said planar top surface, said elastic planar top and said elastic peripheral wall being elastically stretchable to a stretched size where said peripheral wall can receive the open top of the vase therein and said elastic planar top spans the open top of the vase, wherein said peripheral wall engages the vase around the open top by contracting around the open top.

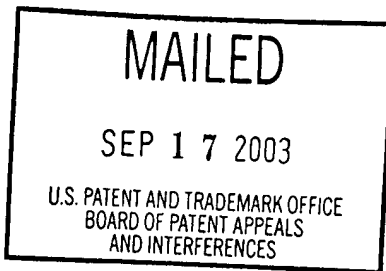


The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 11

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES



Ex parte LINDA ROSKIN

Appeal No. 2003-1855  
Application No. 09/874,031

ON BRIEF

Before FRANKFORT, NASE, and BAHR, Administrative Patent Judges.  
NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 5 to 22, which are all of the claims pending in this application.

We REVERSE.



### BACKGROUND

The appellant's invention relates to devices and methods that are used to divide a container into sections so that the container can better be used to hold a designed floral arrangement. More particularly, the present invention relates to partitioned covers for vases, and other traditional flower holding containers, that assist in the formation of a floral design (specification, p. 1). A copy of the dependent claims under appeal is set forth in the appendix to the appellant's brief. Claims 11, 19 and 22, the independent claims on appeal, read as follows:

11. An assembly, comprising:
  - a container having an open top end with a predetermined maximum width;
  - an elastomeric cover element for covering said open top end, said cover element having an unstretched width that is smaller than said maximum width of said open top end wherein said cover element must be elastically stretched to a stretched width greater than said maximum width of said open top end to cover said open top end; and
  - a plurality of openings defined in said cover element.
19. A method of preparing a vase for a floral arrangement, wherein the vase has an open top with a maximum width at least one point, said method comprising the steps of:
  - providing an elastomeric cover, containing a plurality of openings therein, said elastomeric cover having a width that is less than said maximum width of said vase;
  - stretching said elastomeric cover over said open top of said vase, wherein said width of said elastomeric cover elastically increases to a width greater than that of said vase and engages said vase around said open top.
22. A floral arrangement cover for a vase, wherein the vase has an open top, said cover comprising:
  - an elastic planar top surface in which are defined a plurality of openings;
  - an elastic peripheral wall that extends downwardly from said planar top surface, said elastic planar top and said elastic peripheral wall being elastically

stretchable to a stretched size where said peripheral wall can receive the open top of the vase therein and said elastic planar top spans the open top of the vase, wherein said peripheral wall engages the vase around the open top by contracting around the open top.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Saks et al. (Saks)	2,876,587	Mar. 10, 1959
Eckman	3,768,685	Oct. 30, 1973
Turner	EP 0 182 453 A1	May 28, 1986

Claims 5 to 7, 9 to 15 and 17 to 22 stand rejected under 35 U.S.C. § 103 as being unpatentable over Turner in view of Eckman.

Claims 8 and 16 stand rejected under 35 U.S.C. § 103 as being unpatentable over Turner in view of Eckman and Saks.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections, we make reference to the final rejection (Paper No. 5, mailed September 18, 2002) and the answer (Paper No. 9, mailed May 9, 2003) for the examiner's complete reasoning in support of the rejections,

and to the brief (Paper No. 8, filed February 25, 2003) for the appellant's arguments thereagainst.

### OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by the appellant and the examiner. Upon evaluation of all the evidence before us, it is our conclusion that the evidence adduced by the examiner is insufficient to establish a prima facie case of obviousness with respect to the claims under appeal. Accordingly, we will not sustain the examiner's rejection of claims 5 to 22 under 35 U.S.C. § 103. Our reasoning for this determination follows.

In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). A prima facie case of obviousness is established by presenting evidence that the reference teachings would appear to be sufficient for one of ordinary skill in the relevant art having the references before him to make the proposed combination or other modification. See In re Lintner, 458 F.2d

1013, 1016, 173 USPQ 560, 562 (CCPA 1972). Furthermore, the conclusion that the claimed subject matter is prima facie obvious must be supported by evidence, as shown by some objective teaching in the prior art or by knowledge generally available to one of ordinary skill in the art that would have led that individual to combine the relevant teachings of the references to arrive at the claimed invention. See In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). Rejections based on 35 U.S.C. § 103 must rest on a factual basis with these facts being interpreted without hindsight reconstruction of the invention from the prior art. The examiner may not, because of doubt that the invention is patentable, resort to speculation, unfounded assumption or hindsight reconstruction to supply deficiencies in the factual basis for the rejection. See In re Warner, 379 F.2d 1011, 1017, 154 USPQ 173, 178 (CCPA 1967), cert. denied, 389 U.S. 1057 (1968). Our reviewing court has repeatedly cautioned against employing hindsight by using the appellant's disclosure as a blueprint to reconstruct the claimed invention from the isolated teachings of the prior art. See, e.g., Grain Processing Corp. v. American Maize-Products Co., 840 F.2d 902, 907, 5 USPQ2d 1788, 1792 (Fed. Cir. 1988).

With this as background, we analyze the prior art applied by the examiner in the rejection of the claims on appeal.

Turner's invention is related to the protection of potted growing plants during shipping. As shown in Figure 1, a plant 5 is planted or grown in a pot 16 in potting soil 6 covered with a relatively thin layer of fibrous bedding material 7, usually about one-half to one and one-half inches thick, to hold the potting soil in place during shipping of the potted plant. An open-mesh cover 10 is placed over and against the layer of bedding material and secured to the pot to hold the bedding material, and thus the potting soil, in place.

In one of Turner's embodiments, the open-mesh cover comprises a set of one-sixteenth inch diameter plastic rods spaced one inch apart and fastened to a second set of such rods having their longitudinal axis at an angle of about 90 degrees from the longitudinal axis of the first set of rods. In this embodiment, the pot is provided with a lip extending around the inside surface of the pot near its top. The open-mesh cover is trimmed to fit inside the pot and snapped into place beneath the lip.

Turner's preferred embodiment of open-mesh cover is shown in Figures 2 and 3. This cover comprises a ring 10 of O-shaped cross-section as shown in Figure 3 having a size and shape such that when inverted it fits over the upper rim 14 of the pot 16 and is held securely in place by a snap-lock mechanism shown in Figure 3. Turner teaches (page 4, lines 28-31) that "[a]ny other suitable means may be employed for securing the

ring 10 to the top of the pot 16, and is easily provided by persons having skill in the art." The open-mesh portion of the cover is formed by attaching filaments 12 to the ring 10 about one-half to 1.5 inch apart. Plastic filaments are preferred elements for forming the open-mesh cover; however, ribbons, rods, wires, etc., may also be used.

Eckman's invention relates to a new and different type of vial device which provides a holder for a corsage combined with a container for perfume or other fragrant liquid, together with means for connecting the vial with a decorative bow, a corsage, pin for a corsage, and a decorative net or bow. As shown in Figures 1-4, Eckman's invention comprises a vial device 10 which includes a tubular body 12 which serves as a holder for a corsage and a container receptacle for perfume or other types of fragrant liquid. The tubular body is open at one end 14, which end is surrounded by a rubber or other suitable resilient cap 18 held in place by friction fit over a lip edge 16 at the open end of the vial. The rubber cap has a relatively small opening 20 in its center. Eckman teaches (column 1, lines 40-42) that the vial device serves as a container for perfume or other fragrant liquid which is easily portable and readily usable.

One side of the tubular body of Eckman is provided with an attachment means 22 formed into a rounded projection or a pointed arrow head (Figure 5), on which a bow

can be snapped on. A holding means 28 for a corsage pin and for a net is provided on the tubular body's opposite side from the attachment means 22. The holding means 28 has a top portion formed into a prong-like extension 30 for accepting a folded netting bow. The bottom portion of the holding means has one or more holes 34 to receive and maintain a corsage pin secured to a corsage (not shown).

In operation, Eckman's tubular body 12 of the vial device 10 is filled with the desired perfume or other fragrant liquid and the cap 18 placed over the lip edge 16. As desired, a bow having a snap means 24 is placed around the attachment means 22 of the vial device 10, and a corsage pin is secured to an opening 34. A net may also be secured around prong extension 30.

Saks' invention relates to a candlestick flower arranger. As shown in Figures 1-4, a candle-stick holder 10 having a base portion 11 with a finger grip portion 12 thereon and an upstanding portion 13 having an opening 14 with a tapered lower end 15 into which the lower end of a candle 16 is seated and retained in the usual manner. With the candle in place, there is fitted a container 16' over the candle and slid downwardly for support upon the upper end of the upstanding portion 13 of the candlestick holder. This container has a central tubular upstanding sleeve portion 17 providing a vertical opening 18 to accommodate the candle 16. The upstanding sleeve

portion 17 extends upwardly beyond the upper edge of flange 20 to accommodate a separate annular shaped grill or perforated member 21 having a central opening 22 adapted to receive the upper end of the sleeve portion 17 and sufficiently wide to extend over the flange 20 and rest thereupon. This member 21 is also preferably made of plastic or transparent material. The opening 22 has diametrically opposed notches 23 and 24 adapted to respectively permit the member 21 to be set over diametrically-opposite radially-extending projections 25 and 26 on the upper end of the sleeve portion 17. After the member 21 is in place and has been rotated slightly so that the notches are out of registry with the projections 25 and 26, the member 21 is locked upon the flange 20 of the container and held against disengagement therefrom. With the container 16' in place upon the candlestick holder, the same can be partly filled with water and thereafter the grill member 21 can be fitted over the sleeve portion 17 and rotated to be locked under the projections 25 and 26. With the member 21 in place and the arranger fully assembled upon the candlestick, flower stems 27 can be inserted through any one of a plurality of holes 28 in the member 21 and into the water contained therein.



In the rejection of independent claims 11, 19 and 22 before us in this appeal (final rejection, p. 2), the examiner (1) ascertained<sup>1</sup> that "Turner does not explicitly teach that the cover is elastomeric having an unstretched width that is smaller than the maximum width of the open top;" and (2) concluded that:

It would have been obvious to one of ordinary skill in the art to modify the teachings of Turner since the modification is merely an engineering design choice of selecting a known material for intended use to obtain a tight frictional seal over the opening as taught by Eckman (Eckman Col. 1 line 20-22).

The appellant argues in the brief that there is no teaching, suggestion or motivation in the applied prior art (i.e., Turner, Eckman and Saks) for a person of ordinary skill in the art, at the time the invention was made, to have modified Turner to arrive at the subject matter of independent claims 11, 19 and 22. We agree. In that regard, it is our view that the teachings of Eckman would not have provided an artisan with any reason to have modified Turner's cover to be an elastic cover as set forth in independent claims 11, 19 and 22. The mere fact that the prior art could be modified in the manner suggested by the examiner does not make such a modification obvious unless the applied prior art suggested the desirability of the modification. See In re Gordon, 773 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984). In this case, the applied prior art does not suggest the desirability of the modification.

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<sup>1</sup> After the scope and content of the prior art are determined, the differences between the prior art and the claims at issue are to be ascertained. Graham v. John Deere Co., 383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966).

## CONCLUSION

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) APPEALS  
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